

REMARKS

Claims 1, 4, 5, 8-21 are pending.

Amendment to Claim 1

A minor editorial change has been made to claim 1. The Examiner is requested to approve this change. In Section 2 of the Office Action, the Examiner stated that the rejection based on Goldhaber was overcome. It is assumed that this was the rejection under 35 USC 102 previously presented.

Reply to Rejections

First Rejection

Claims 1, 4, 5, 8-10, 12-16 were rejected under 35 USC 103(a) as being unpatentable over Goldhaber (USP 5,794,210) in view of Reilly (USP 5,740,549). In explaining the rejection, the Examiner identified parts of Goldhaber that were relied on. These parts are as follows: Goldhaber discloses that only non-duplicative advertising information is saved on the user computer, column 20, lines 10-26, column 14, lines 59-67. These columns and lines are as follows:

If someone wants to make a new offer to sell something (Fig. 15 block 450), system 100 can create an associated selling agent 402 (Fig. 15 block 452). Similarly, a new request to purchase an item (Fig. 15 block 454) may result in creation of a buying agent 110 (Fig. 15 block 456). The above-described processes may exist concurrently with the agent functions described above in connection with attention brokering

- which result in the creation of agents to "buy" or "sell" consumer attention as a commodity (Fig. 15, blocks 458, 460, 462, 464). The trading houses 400 may then create one or more indexes of items being bought and sold (Fig. 15 block 466). When a buying agent 110 and a selling agent 402 meet at a trading house computer 400, the trading house computer scans for buy/sell matches (Fig. 15 block 468), and may screen out all matches that have already been previously provided to that particular prospective buyer and/or seller to avoid duplications (Fig. 15 block 470).

Interest is still any advertiser's primary tool for grabbing attention. When you sign up with us and fill in your profile, we build a personal agent for you. This agent works around the clock, searching out and screening new ads to find ones that match your interests. The next time you log in, these ads are waiting for you. If your agent ever finds an ad you don't like, it takes your feedback and modifies its behavior accordingly. There's no reasons to put up with ads that don't interest you.

Note that the offer to sell something cited (column 20, lines 10-26) above are functionally equivalent to an advertisement and also Goldhaber discloses presenting advertising (column 1, lines 15-30). Column 1, lines 15-30 states as follows:

Historically, advertising has involved a battle of wits between advertiser and consumer. In the mass media, producers of products and services vie with each other to capture the attention of potential consumers, while those same consumers (although generally endorsing the idea of advertising as a way of keeping entertainment and information costs down) strive to evade as many advertising messages as they can. Consumers press the mute button on their TV remotes and "zap" advertisements by flipping between channels, they mentally tune out or "zap" radio commercials, they flip advertising pages of a newspaper or magazine without paying any attention to

them, and they subscribe to non-commercial information and entertainment media. Rare indeed is the consumer who actually enjoys being at the receiving end of mass-media advertising.

Furthermore, in the above citation, column 16, lines 24-41 (note that Goldhaber tracks what advertisement to use, that the advertisements are stored on the user's computer. Column 16, lines 24-41 states as follows:

When the software agent arrives at the attention brokerage server 106, it scans the ad index maintained by the attention brokerage server to look for matches between its consumer's interest profile 124 and indexed demographic information corresponding to the ads maintained by the attention brokerage serve (Fig. 11A, block 184). The software agent 110 and/or the attention brokerage server 106 may remove from the list of matches all ads that the consumer has already viewed (or has viewed within a particular time frame) (Fig. 11A, block 186). The software agent 110 may then return to the consumer's computer 104 with a file of thumbnail descriptions of each matching ad (Fig. 11A, block 188). The software agent 110 may display the contents of this thumbnail file on the consumer's computer 104 along with CyberCoin icons 62. Selecting the associated CyberCoin icon 62 initiates an interaction between the consumer's computer 104 and the attention brokerage server 106 that stores the matching ad (see below).

Goldhaber further discloses that said benefits are updated according to the number of times or a time period said advertising information is presented (column 30, lines 4-8). Column 30, lines 4-8 states as follows:

A method as in claim 45 wherein step (2) establishes a compensation range that may vary from at least one of (a) user to user, (b) item to item, and (c) time to time.

Before discussing the reasons why the claims are patentable over the two references cited, first a comment as to Goldhaber is set forth. In stating that "offers... are functionally equivalent to an advertisement" this in fact is incorrect. See the definition of these two terms in Black's Law Dictionary,¹ which states as follows:

offer: 1. The act or an instance of presenting something for acceptance < the prosecutor's offer of immunity> 2. A promise to do or refrain from doing some specified thing in the future, conditioned on an act, forbearance, or return promise being given in exchange for the promise or its performance; a display of willingness to enter into a contract on specified terms, made in a way that would lead a reasonable person to understand that an acceptance, having been sought, will result in a binding contract <she accepted the \$750 offer on the Victorian armoire>

advertising. 1. The action of drawing the public's attention to something to promote its sale. 2. The business of producing and circulating advertisements.

While the Examiner states that Goldhaber does disclose advertising, this is an isolated disclosure in Goldhaber explaining prior art. Also, the Examiner stated that "Goldhaber further discloses that said benefits "it is not clear from the Office Action what said benefits relates to." With respect to

¹ Eighth Edition, 2004

Reilly, even if this reference shows what is set forth in the Office Action, it does not cure the innate deficiencies of a rejection that includes Goldhaber and thus there is no *prima facie* case of obviousness established.

It appears what the Office Action has done is merely picked and chosen isolated disclosures in the prior art, which includes both of the references.

Even if the references show the elements claimed, which they do not, as stated above, it is impermissible to only pick and choose from the references elements to support the rejection. See In re Wesslau, 147 USPQ 391 (CCPA 1951) wherein the Court stated as follows:

In re Wesslau, 353 F.2d 238, 147 USPQ 391 (CCPA 1951)
Impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.
Piecemeal reconstruction of prior art patents is improper, In re Kamm, 452 F.2d 1052, 172 USPQ 298 (CCPA 1972)

Piecemeal reconstruction of prior art patents is improper.
See In Re Kamm, 172 USPQ 298, (CCPA 1972).

The dependent claims are considered patentable at least for the same reasons as their base or intervening claims.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claims under 35 USC 103.

Second Rejection

Claim 11 was rejected under 35 USC 103(a) as being unpatentable over Goldhaber in view of Reilly and in view of Gerace (USP 5,848,396). This rejection is traversed.

Claim 11 is dependent on claim 10. As discussed supra, the first two references do not suggest the structure of claim 10. The addition of Gerace does not cure the innate deficiencies of a rejection based on the first two references.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection under 35 USC 103.

Third Rejection

Claims 17-21 were rejected under 35 USC 103(a) as being unpatentable over Goldhaber in view of Reilly, in view of Steele et al. (USP 6,564,047) and in view of Rautila (USP 6,524,189). This rejection is traversed.

The addition of Steele et al. and Rautila do not cure the innate deficiencies of a rejection based on the first two references as explained above. Note claims 17-21 are dependent claims.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claims under 35 USC 103.

Additional art was cited. As this art has not been applied, no further comments are considered necessary.

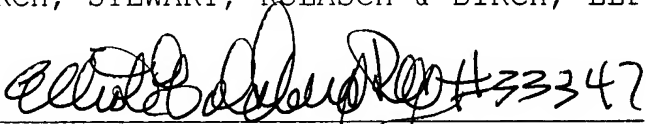
Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Elliot A. Goldberg (Reg. No. 33,347) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By  #33347
for Terrell C. Birch, #19,382

TCB/EAG/jm/kmr
0033-0684P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000